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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/473,277 | 12/28/1999 | HIROSHI KOIKE | 500-38037XOO | 9791 |

20457 7590 01/27/2004

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

EXAMINER

WORLOH, JALATEE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,277

Applicant(s)

KOIKE ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,24,26,29 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,24,26,29 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed November 26, 2003 have been fully considered but they are not persuasive.

Applicants disagree with the 35 USC 101 rejection of claims 22, 29 and 32. Applicants' arguments were considered; however, the rejection will not be withdrawn. The invention in the body of the claims does not include any technological features (e.g. hardware, computing device); therefore, technology must be included in the claims' body.

As per the response regarding Muyres et al, Applicants argue that Muyres et al. do not disclose digital contents distributed from the content database center via the distribution management center to the vending device of a store without a distribution request from the store...; however, there is no indication of a content database center, distribution management center or a vending device within the claims. Thus, Applicants are advised to consider revising the claims' body to include the possible distinct feature; otherwise, Muyres et al. in view of Miller et al. and/or Van Wie et al teach the recited claims.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22, 29 and 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing

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more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452. .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22, 26, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/0002488 to Muyres et al. in view of U.S. Patent No. 5920701 to Miller et al.

Referring to claims 22, 29 and 32, Muyres et al. disclose selecting digital contents corresponding to each of a plurality of stores selling said digital contents, when said selected digital contents is not saved in said stores and selling at each of said stores a particular digital content selected by a customer from said distributed digital contents (see paragraphs [0092] and [0127]). Muyres et al. do not expressly disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of

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said digital contents to each of said stores according to said distribution schedule. Miller et al. disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule (see col. 1, lines 66-67; col. 2, lines 1-7). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Muyres et al. to include the step of generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule. One of ordinary skill in the art would have been motivated to do this because it accurately coordinates the transfer of data (see Miller et al. col. 1, lines 44-55).

Referring to claim 26, Muyres et al. disclose a distribution control section for selecting digital contents corresponding to each of a plurality of stores selling said digital contents, when said selected digital contents is not saved in said stores and a sales section for selling at each of said stores a particular digital content selected by a customer from said distributed digital contents (see paragraphs [0092] and [0127]). Muyres et al. do not expressly disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule. Miller et al. disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule (see col. 1, lines 66-67; col. 2, lines 1-7). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Muyres et al. to include the process of

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generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule. One of ordinary skill in the art would have been motivated to do this because it accurately coordinates the transfer of data (see Miller et al. col. 1, lines 44-55).

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muyres et al. and Miller et al. as applied to claim 22 above, and further in view of U.S. Patent No. 5943422 to Van Wie et al.

Muyres et al. disclose selling at each of said stores, a particular digital content selected by a customer from said distributed digital contents (see claim 22 above). Muyres et al. do not expressly disclose generating a digital content by digitizing an original content and transmitting to a recognition device a request for confirmation of content of said digital content; executing, in response to said request, confirmation of said content of said digital content by determining whether said content of said digital content has been generated without error and transmitting a message indicating whether said content is to be recognized based on said determination and receiving said message and accumulating said content of said digital content if said content of said digital content has been recognized. Van Wie et al. disclose generating a digital content by digitizing an original content and determining whether said content of said digital content has been generated without error (see col. 11, lines 3-5; col. 39, lines 14-22), and receiving a message accumulating said content of said digital content if said content of said digital content has been recognized (see col. 39, lines 31-33). As per the step of transmitting to a recognition device a request for confirmation of content of said digital content and transmitting a message

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whether said content is to be recognized based on said determination, these are inherent step.

Further, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Muyres et al. to include the steps of generating a digital content by digitizing an original content and transmitting to a recognition device a request for confirmation of content of said digital content; executing, in response to said request, confirmation of said content of said digital content by determining whether said content of said digital content has been generated without error and transmitting a message indicating whether said content is to be recognized based on said determination and receiving said message and accumulating said content of said digital content if said content of said digital content has been recognized. One of ordinary skill in the art would have been motivated to do this because detects and resolves errors during file transfer.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

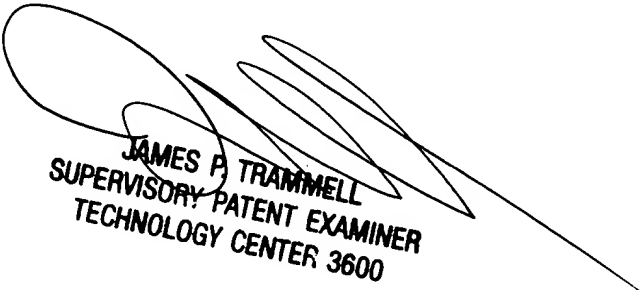
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

January 20, 2004


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**